

REMARKS

The Examiner is thanked for his Office Action. Claims 1-14 and 29-46 are pending. Reconsideration in view of the following remarks is respectfully requested.

35 U.S.C. § 103, Obviousness

The Office Action rejects all claims under 35 U.S.C. § 103(a) as unpatentable over Tognazzini in view of the Official Notice. This rejection is respectfully traversed. The current Office Action repeats the rejection of the first action, without further clarification, stating that:

"All the claims are directed to the use of e-receipt for online transactions wherein all claims' limitations can be found in the US patents of Tognazzini (US Pat. 5,739,512), Vaghi (US Pat. 6,047,273), Beatson et al., (US Pat 5,892,824, and Muftic (US Pat. 5,850,442). In their disclosures, they utilized e-receipts and validating them for different purposes.

The Official Notice is taken here that the following limitations are notorious well-known in the art (at least from cited references):

- processing means for processing a transaction;*
- generating means for generating e-receipts for above transaction;*
- storing means for storing e-receipts;*
- reading means for reading e-receipts;*
- validating means for validating e-receipts;*
- indicating means for providing an indication to proceed with a delivery of related goods/services;*
- inspection means for inspecting a digital signature of e-receipts.*

The examiner submits that all claimed limitations are so obvious/notoriously well-known in a computer system, because these claimed limitations are very broad that they are easily recognized by artisan in the art to be ability/features/components of a computer system and said components would perform claimed tasks/steps; cited prior art's limitations are not necessary spelled-out exactly claimed languages, because cited prior art is also directed to a similar process/system for communicating between sellers and buyers through e-receipts. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although cited disclosures have been described in connection with specific preferred embodiments, it would be understood that their subject matter should not be unduly limited to such specific embodiments."

It is noted that despite Applicant's request, the Examiner has not shown specific portions of any of the references on which he relies for particular claim rejections, but has persisted in his very generalized rejections. It is submitted that this approach ignores the overall thrust of the application and claims and rejects them by a piecemeal compilation from a number of sources. The courts have ruled that this is improper.

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986).

It is submitted that one of ordinary skill in the art would not be motivated to make the examiner's proposed modifications to reach the presently claimed invention when the cited references are considered as a whole.

Programs which handle the sale of merchandise or services write receipts. They may write them and give the receipt to a consumer, or save them for their records, or if they are acting as an intermediary in e-commerce between the seller and the consumer, they may send the receipt to a third party (the seller) who actually delivers the goods. However, the programs that write receipts do not generally turn around and then read those receipts, as is claimed in numerous claims - there has simply not been a motivation previously to do so. However, in adapting the use of portable e-receipts to face-to-face commerce, the inventors of the presently claimed invention have found a motivation, missed by others, to have the same program both write and then read the receipt: the electronic receipt has been in the consumer's hands as a way to show that purchase, but not delivery, has been made, much in the way that paper receipts have been used for this purpose previously. **The Examiner has nowhere shown a comparable motivation in the prior art for the specific claimed limitations.**

Five claims are directed to computer program products, Claims 25, 27, 37, 43, and 46. Each of these claims recites that the program both writes the receipt and that it then reads the receipt. It is submitted that no motivation has been shown to provide this specific combination of limitations in one program. Additionally, most of these claims recite at least one additional limitation which will be discussed below, in conjunction with the method claims.

One group of claims provide the limitation that a physical, removable storage medium is presented for validation of the electronic receipt which it carries. This is seen in independent method Claims 1 and 5.

Exemplary Claim 1 recites *"receiving the removable storage medium at a second data processing terminal at a different time or location [from where it was recorded]; validating the electronic receipt"*.

Claim 5 recites *"receiving a removable storage medium; reading an electronic receipt from said removable storage medium; [and] validating the electronic receipt"*.

It is noted that each of the above listed claims is a method claim. The claims do not just recite elements of a transaction; they recite methods in which these elements are used together to achieve an end. Each of these claims recites that a removable storage medium is received in order to process the electronic receipt on it; while the prior art deals with removable storage media and electronic receipts, the specific actions recited are not disclosed in the art relied on. **Tognazzini** focuses on the idea of sending e-receipts through the e-mail system, although he does recognize that an e-receipt can be placed on a removable storage device. **Tognazzini** does not validate an electronic receipt so received. **Muftic** discusses using electronic commerce over an open network; **Muftic** is not concerned with the use of electronic receipts on a removable storage media. **Vaughn** is aimed at providing services (e.g., providing mailing/shipping prices) electronically over the internet; **Vaughn** is not concerned with electronic receipts on a removable storage media. **Beatson** deals with electronically capturing a signature, e.g., for a credit card receipt, and with validating that signature; **Beatson** is not concerned with the use of electronic receipts on a removable storage media; **Pare, Jr. et al.** uses a biometric sample (e.g., fingerprint, DNA sample) for identification in an electronic commercial transaction, but does not appear to deal with electronic receipts carried on a removable storage media; **Stambler** uses a sophisticated method of authenticating a transaction, but does not discuss an electronic receipt carried on a removable storage media; **Anderson** discusses a means for storing documents electronically in a manner that allows them to be both human readable and computer readable, **Anderson** does not

discuss an electronic receipt carried on a removable storage media;

PGPUB-Document-Number 200010018739, like Anderson discusses a means for storing documents electronically in a manner that allows them to be both human readable and computer readable; this document does not appear to discuss an electronic receipt carried on a removable storage media. **These patents do NOT deal with, nor do they suggest, the claimed actions.** Applicants are not claiming the field of electronic commerce, but they are claiming the specific use of a portable storage media used to physically carry electronic receipts for multipart transactions, such as a purchase and delivery that are physically separated by time and/or space.

Another group of claims recite the limitation that it is upon validation of the electronic receipt that an inventory is updated, this limitation is seen in independent method Claim 3 and independent program Claim 27. It is submitted that the references relied on by the Examiner do not even address the idea of inventory control in conjunction with electronic receipts, yet the Examiner is apparently arguing that one of ordinary skill in the art would look to these patents to meet claimed limitations that directly deal with inventory control.

Claim 3 recites *"in response to validating the electronic receipt ... updating an inventory affected by said delivery of goods or services"*.

Claim 27 recites *"seventh instructions for updating an inventory in response to validating the electronic receipt"*.

Again, these claims recite actions or instructions that are not presented in this manner in the prior art relied on, specifically, updating inventory when the goods are delivered, NOT when they are purchased.

Tognazzini does not discuss inventory control; **Muftic** does not discuss inventory control; **Vaughn** does not discuss inventory control; **Beatson** does not discuss inventory control. **Pare, Jr. et al.** does not discuss inventory control; **Stambler** does not discuss inventory control; **Anderson** does not discuss inventory control; **PGPUB Document Number 200010018739** does not discuss inventory control. Since none of these even

discuss control of inventory, they cannot disclose limitations related to control of inventory.

Another set of claims deals with updating an electronic receipt carried on a removable storage media; this limitation is seen in independent method Claim 34 and independent program Claim 37. It is submitted that few of the references relied on even discuss the use of electronic receipts on a removable storage media

For example, exemplary claim 34 recites *"receiving a removable storage media containing a first electronic receipt ... updating said first electronic receipt to reflect said new transaction"*.

Claim 37 recites *"fourth instructions for reading said first electronic receipt from the removable storage medium ... and sixth instructions for modifying said first electronic receipt"*.

As mentioned in the discussion of Claim 1, only Tognazzini, of all the patents cited, appears to appreciate storing electronic receipts on physically removable media, which can be transported from place to place. Tognazzini does not appear to appreciate that this ability can be used to simplify the physical handling of receipts, such as the ability to update the receipt to reflect new stages in a multi-part transaction.

A further set of claims deals with the ability to store added information on an electronic receipt, which can add value for the consumer. This is seen in independent method Claim 40 and independent program Claim 43.

For example, claim 40 recites *"storing an electronic receipt for said commercial transaction on a computer readable media, wherein said electronic receipt contains additional information beyond that given to document the transaction; giving said computer readable media to a customer"*.

Claim 43 reads *"third instructions for storing said electronic receipt on a removable storage medium, along with additional information beyond that given to document the transaction"*.

Once an electronic receipt is carriable by the consumer, it is of added value to the consumer to sometimes have additional information stored on the receipt. Once again, only Tognazzini appears to address the use of physical media given into possession of the consumer, but he does not appear to store this additional information at the same time.

It is further noted that dependent claims recite specific information that is useful to store on the electronic receipt, but which are not found in the prior art. Claim 41 recites storing a credit card number used to pay for the item when an extended warranty is thereby given. Claim 42 recites storing instructions for using an item purchased in the transaction itemized by the receipt.

A final set of claims deals with providing the consumer with an electronic receipt that he may use as necessary, but which the consumer is unable to alter at home, due to encryption. This is seen in independent method Claim 45 and independent program Claim 46.

Claim 45 recites *"storing an encrypted electronic receipt for said commercial transaction on a computer readable media using an encryption method known only by the provider; giving said computer readable media to a customer"*.

Claim 46 recites *"third instructions for storing said first electronic receipt on a removable storage medium in an encrypted form"*.

Again, a media that can physically carry the electronic receipt is disclosed only in Tognazzini; which does not discuss the idea of encrypting the receipt. None of the other references suggest this specific limitation either.

In summary, the examiner has ignored numerous specific limitations in the claims whose combinations are not shown by the prior art. The rejections under 103 are now overcome.

Conclusion

It is respectfully urged that the rejections have been overcome and that the claimed subject matter is patentable over Tognazinni and the Official Notice and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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